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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,392	07/03/2003	Ronald J. Rosenberger		7234

7590  
Ronald Rosenberger  
506 Sterling St.  
Newtown, PA 18940

09/12/2007

EXAMINER
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MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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09/12/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/613,392

**Applicant(s)**

ROSENBERGER, RONALD J.

**Examiner**

James W. Myhre

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is in response to the preliminary amendment filed on January 23, 2004. The preliminary amendment did not add or delete any claims, but amended Claims 1-42. Therefore, the currently pending claims considered below remain Claims 1-42.

### ***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 4-21 and 25-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The above claims contain numerous steps "for enabling" entities to perform one or more steps. However, the claims do not explicitly include actually performing any steps, only that the entity, e.g. "said applications and said accounts", are able to perform the following steps. Thus, it is unclear as to whether or not these steps are part of the claimed invention. In order to clearly define the scope of the applicant's invention each

step that is to be considered part of the invention should be specifically recited as being performed, not just able to be performed. Any general purpose computer can be "enabled" to perform any step merely by entering the proper programming code.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2-10, 15-20, 23-31, and 36-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The following is a quote from MPEP 2106:

**\*\*>**The courts have also held that a claim may not preempt< ideas, laws of nature or natural phenomena. The concern over preemption was expressed as early as 1852. See *Le Roy v. Tatham*, 55 U.S. 156, 175 (1852) ("A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right."); *Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 132, 76 USPQ 280, 282 (1948) (combination of six species of bacteria held to be nonstatutory subject matter).

**\*\*>**Accordingly, one may not patent every "substantial practical application" of an idea, law of nature or natural phenomena because such a patent would "in practical effect be a patent on the [idea, law of nature or natural phenomena] itself." *Gottschalk v. Benson*, 409 U.S. 63, 71-72, 175 USPQ 673, 676 (1972).

The above claims include such pre-emptive language, such as "said applications and said accounts to comprise applications and accounts for any type of service or product....said communications to comprise anything relevant or non-relevant to the

activity of said account" (Claim 5); "said file comprising mentions/advertisements to comprise any information that is desired....access to said file to comprise any communicative means or embodiment that enables said file to be accessed" (claim 8), etc.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manchester et al (US 2003/0204470) in view of Postrel (US 2005/0021400).

Claims 1 and 22: Manchester discloses a system and method, comprising:

- a. distributing applications containing a promoter code to users and receiving/processing completed applications (page 1, paragraph 0009 and page 2, paragraph 0017);
- b. establishing an account for a user based on the application and promoter code (page 1, paragraph 0009 and page 2, paragraph 0017); and
- c. sending mentions/advertisements to the user based on the promoter code (page 1, paragraph 0012 and page 2, paragraph 0024).

While Manchester does not explicitly disclose establishing (storing) a file (database) containing the mentions/advertisements being sent to the user, nor explicitly a database containing the promoter codes, Postrel discloses a similar system and method in which a database has been established for storing information/advertisements to be sent to the user of the credit card based on the credit card's sponsor (promoter) (page 8, paragraph 0081). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Manchester to have established a database to store the mentions/advertisements being sent to the users and a database for storing the promoter codes for identifying the sponsors of the credit cards. One would have been motivated to establish these databases in order to allow Manchester to select the appropriate mention/advertisement to send to the user, even if the promoter was not connected to the network at that specific time.

Claims 2 and 23: Manchester and Postrel disclose a system and method as in Claims 1 and 22 above, and Manchester further discloses that the steps are performed by an entity. The Examiner notes that the Applicant is claiming that the entity could be anyone...the offering entity, or any of one or more third party entities, i.e. anyone. It is inherent that some entity in Manchester must be performing the steps.

Claims 3, 20, 24, and 41: Manchester and Postrel disclose a system and method as in Claims 1 and 22 above, and Manchester inherently discloses eliminating, enhancing, or

adding method steps (Examiner Note. This would cover any method which is not exactly word-for-word with the Applicant's claim).

Claims 4-6 and 25-27: Manchester and Postrel disclose a system and method as in Claims 1 and 22 above, and Manchester further discloses using various types of cards, various types of accounts, and various type of communication means and messages (i.e. transmitting any type of messages for any type of card holder or any type of communication channel) (page 1, paragraph 0009 and 0012, and page 2, paragraph 0024).

Claims 7 and 28: Manchester and Postrel discloses a system and method as in Claims 1 and 22 above, and Manchester further discloses the communications including any type of mentions/advertisements (page 1, paragraph 0012 and page 2, paragraph 0024).

Claims 8, 9, 29, and 30: Manchester and Postrel disclose a system and method as in Claims 1 and 22 above, and Postrel further discloses the files being able to be added to, modified, or deleted by the entities (page 3, paragraph 0032 and page 6, paragraph 0066). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to enable one or more of the entities in Manchester to access the files in order to add, delete, or amend the files. One would have been

motivated to allow such file maintenance by the entities in order to keep the data in the databases up-to-date as is normal within the database arts.

Claims 10, 16-18, 31, and 37-39: Manchester and Postrel disclose a system and method as in Claims 1 and 22 above, and Manchester further discloses using any communicative embodiment or format (page 2, paragraphs 0021-0022).

Claims 11-13 and 32-34: Manchester and Postrel disclose a system and method as in Claims 1 and 22 above, and Postrel further discloses a single or plurality of promoters and promoter codes (page 2, paragraph 0029). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a single or plurality of promoters (sponsors) in Manchester. One would have been motivated to include one or more promoters (sponsors) in order to implement the sponsored credit card system of Manchester.

Claims 14 and 35: Manchester and Postrel disclose a system and method as in Claims 1 and 22 above. While neither of the references explicitly disclose that the mentions/advertisements will be presented to the user for a limited or unlimited time period, it would have been obvious to one having ordinary skill in the art at the time the invention was made to set or not to set a time limit for the inclusion of the advertising. One would have been motivated to set a time limit or not to set a time limit in order to cover temporary or non-temporary credit cards.



Claims 15 and 36: Manchester and Postrel disclose a system and method as in Claims 1 and 22 above. While neither reference explicitly discloses the offering entity charging a fee to the promoter (sponsor), it would have been obvious to one having ordinary skill in the art at the time the invention was made to charge the promoter a fee. One would have been motivated to charge the promoter a fee as it is common practice in the marketing art to charge an advertiser a fee for placing their advertisement in front of a consumer.

Claims 19, 21, 40, and 42: Manchester and Postrel disclose a system and method as in Claims 1 and 22 above, and Manchester further discloses allowing access to the listings (page 2, paragraph 0024).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Ward (3,647,275) discloses a system and method for producing credit cards with holographic images of the cardholders that also include indicia of the sponsor and the issuer.

b. Walker et al(5,945,653) discloses a system and method for establishing credit card accounts that present personalized messages on the credit card statements or other notices such as the receipt.

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c. Phillips et al (6,615,189) discloses a system and method for creating purchase card accounts including a personalized message embossed onto the card and presented each time the card is used for a transaction.

d. Zalewski et al (7,155,199) discloses a system and method for presenting advertisements and multimedia presentations to a sponsored credit card customer.

e. Cohagan et al (7,163,145) discloses a system and method for a multiple service card that is linked to a plurality of sponsors.

f. Slater (US 2003/0033246) discloses a system and method for a sponsor funded stored value card that includes a database of sponsors and allows the sponsor to add, delete, or change the information in the database.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JWM  
September 5, 2007



James W. Myhre  
Primary Patent Examiner